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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,595	03/19/2004	Eric W. Rubie	55508-301656	9551
25764 7590 11/19/2009 FAEGRE & BENSON LLP PATENT DOCKETING - INTELLECTUAL PROPERTY 2200 WELLS FARGO CENTER 90 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-3901				
EXAMINER				
MILLER, CHERYL L				
ART UNIT		PAPER NUMBER		
3738				
NOTIFICATION DATE		DELIVERY MODE		
11/19/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

e-OfficeActionHNI@faegre.com
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Office Action Summary

Application No.

10/804,595

Applicant(s)

RUBIE ET AL.

Examiner

CHERYL MILLER

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14, 17, 19, 20, 22-25, 29, 32-46, 48-50 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53 is/are allowed.
- 6) ☒ Claim(s) 2-4, 8-11, 14, 23-25, 29, 32-35 and 38-44 is/are rejected.
- 7) ☒ Claim(s) 5-7, 12, 13, 17, 19, 20, 22, 36, 37, 45, 46 and 48-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachments 1-4

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 2-14, 17, 19, 20, 22-25, 29, 32-46, and 48-50 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed August 24, 2009 have been fully considered but they are not persuasive.

The applicant has argued that Mosler (US 6,767,370 B1) does not disclose only a single upper plate (instead two upper plates 9 and 10). The examiner disagrees. Upper plate may be considered leaf spring 3 (which includes 9 and 10 as one spring piece). Or, upper plate may be considered 10, since the claim requires a prosthesis *comprising* a single upper plate (thus more plates may be present). Applicant may want to consider claiming the lower plate to be longer than the upper plate.

The applicant has argued that Merlette (US 4,959,073) does not have a heel portion at the posterior end of the upper plate. The examiner disagrees. The end of upper plate (adjacent 68) is at/directly above the heel and may be considered the heel portion as it is the most posterior portion. The applicant also has argued that Merlette does not disclose the lower surface of the attachment device contacts and conforms only to the upper surface of the upper plate. The examiner disagrees. The lower surface entirely is not claimed to conform to the upper plate, only a mounting portion of the lower surface. Thus, the mounting portion may be considered lowermost surface of conical attachment on the posterior facing side only, this portion alone only conforms to the upper surface of the upper plate. See attachment 2.

The applicant has argued that Pitkin (US 6,290,730 B1) does not disclose a lower surface of the attachment device contacting and conforming only to the sloped upper surface of the upper plate. The examiner disagrees. The claims do not require the entire lower surface to contact and conform only to the sloped surface, they require a *mounting portion* of the lower surface to contact and conform. Thus the mounting portion may be considered a rear portion of the attachment device, which contacts and conforms only to the sloped surface, see attachment 3.

The applicant has argued that Phillips (US 5,181,932) does not disclose a lower surface of the attachment device contacting and conforming only to the sloped upper surface of the upper plate. The examiner disagrees. The claims do not require the entire lower surface to contact and conform only to the sloped surface, they require a *mounting portion* of the lower surface to contact and conform. Thus the mounting portion may be considered the bottom surface of inward protrusions 42 of attachment device 32, see fig.2, attachment 4.

The applicant has argued that Merlette (US 4,959,073) and Bryant (US 5,728,171) are not combinable as the foot prosthesis attach to a limb in different ways. The examiner disagrees that they are not combinable. Bryant teaches an attachment structure different and an obvious alternative to that shown by Merlette. Also, Bryant's attachment structure is disclosed to be used with different shaped foot prosthesis, thus one shown by Merlette may be applicable to the attachment structure shown by Bryant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 29, 32, 33, 34, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Mosler et al. (US 6,767,370 B1, cited previously). See figure 7 and attachment 1. Mosler discloses a lower leg prosthesis *comprising* a single upper foot plate (3 OR 10) and a sloped upper and lower surface (see figs) towards the heel portion; a lower foot plate (24) disposed below and coupled to the upper plate (3 or 10) to define a space therebetween (see fig.7), the lower plate (24) having a forefoot portion (front or left side of figures at 24a) and a heel portion (back or right side of figures 24b) aligned along a long axis, and an attachment device (4) mounted on the heel portion of the upper plate and including a lower surface having a mounting portion that contacts and conforms to the sloped upper surface of upper plate (3 or 10), a generally horizontal upper surface (dome or flat periphery facing upward that surround the protrusion or that surrounds the dome) and vertical mounting protrusion (top protrusion of adapter, see figs). Mosler shows the attachment device to be wedge shaped and bonded to the upper plate. Mosler shows the protrusion to be a pyramid adapter (see figs.1, 6, 7).

Claims 2-4, 8-11, 14, 23, 25, 33, and 38-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Merlette (US 4,959,073, cited in IDS). Merlette discloses a lower leg prosthesis (figs.1, 2) comprising a single upper foot plate (12+14+16) having a sloped upper surface (see figs); a lower foot plate (20) disposed below and coupled to the upper plate to define a space

therebetween (space occupied by elastomer 24), the lower plate (20) having a forefoot portion (front near 18) and a heel portion (back near 22) aligned along a long axis (the axis extending along the plate 20), the sloped upper surface of upper plate (12+14+16) slopes downward from the heel to the forefoot portion at mid-stance (see figs); and an attachment device (64) including a lower surface (conical surface facing downward) having a mounting portion (bottom and forefoot facing surface) contacting and conforming to the sloped upper surface of upper plate, a generally horizontal upper surface (top surface of 64) and vertical mounting protrusion (70 is a vertical protrusion as is 76; either could be considered the "protrusion" which mounts prosthesis 60).

Claims 25, 29, 32-35, and 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Pitkin et al. (US 6,290,730 B1, cited previously). See figure 11. Pitkin discloses a lower leg prosthesis (figs.11) comprising an upper foot plate (16+14) a sloped upper surface (see figs 1, 2, 11 rear portion of upper plate); a lower foot plate (102) disposed below and coupled to the upper plate to define a space therebetween (104), the lower plate (102) having a forefoot portion (front or right side of fig.11) and a heel portion (back or left side of fig.11) aligned along a long axis (the axis extending along the plate 102), the sloped upper surface of upper plate (upper surface of 16) slopes downward from the heel to the forefoot portion at mid-stance (see figs); and an attachment device (12) including a lower surface (entire bottom surface) having a mounting portion (rear cutout) that contacts and conforms to the sloped upper surface of upper plate (see figs; attachment 3), a generally horizontal upper surface (flat surrounding dome 24) and vertical mounting protrusion (26).

Claims 3, 10, 14, 23, 25, 33, 34, 38, 39, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips (US 5,181,932, cited previously). Phillips discloses a lower leg prosthesis (figs.1) comprising a single upper foot plate (14+50) having a sloped upper surface (see fig.1); a lower foot plate (12) disposed below and coupled to the upper plate to define a space therebetween (space filled by elastomer 70, 72), the lower plate (12) having a forefoot portion (front or right side of fig.1) and a heel portion (back or left side of fig.1) aligned along a long axis (the axis extending along the plate 12), the sloped upper surface of upper plate (upper/right surface of 50) slopes downward from the heel to the forefoot portion at mid-stance (see fig.1); and an attachment device (32) including a lower surface (bottom surface of sleeve 32) having a mounting portion (bottom surface of inward protrusions 42, seen in fig.2 contacting upper surface of upper plate) contacting and conforming only to the sloped upper surface of upper plate (see fig.2), a generally horizontal upper surface (flat upper surface of sleeve 32) and vertical mounting protrusion (30) for mounting a prosthetic component (socket not shown).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 8-11, 14, 23-25, 29, 32-34, 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant, Jr. et al. (US 5,728,171) in view of Merlette (US 4,959,073). Bryant discloses a lower leg prosthesis substantially as claimed. Bryant disclose an attachment

device (10+110; see fig.5) having a lower surface that is mounted to a downwardly sloped upper surface of an upper foot plate in a heel region of the prosthesis (seen in fig.5), the attachment device having a horizontal upper surface (flat surrounding 10 on top of dome, seen clearly in fig.4a) and vertical mounting protrusion (10). Bryant discloses the specific attachment device claimed (see figs.1-5; wedge shape seen in fig.5) and discloses its attachment to a prosthetic foot (fig.5; col.4, lines 21-35), however does not disclose the specific claimed details of the prosthetic foot (arrangement of plates; only one plate is shown in Bryant, not two). Merlette teaches in the same field of prosthetic feet, the use of an alternate prosthetic foot having both an upper and lower foot plates (16 and 20 respectively) spaced by an elastomeric layer (24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Bryant's attachment device for attachment to a prosthetic foot (fig.5), with Merlette's teaching of an alternate prosthetic foot (one with upper and lower plates spaced by elastomeric material; thus modifying Merlette's foot to have the alternate attachment device of Bryant 110+10 instead of 12+64), in order to provide a device of more comfort for the user such that the attachment is located at the heel, not at the knee. Many different prosthetic foot designs are known. Bryant discloses use of a specific attachment device for in general prosthetic feet, one example of which is shown in fig.5, however may be used on any conventional foot prosthesis (col.4, lines 21-35). It makes common sense and thus would have been obvious that since Bryant's attachment device (10+110) is applicable to conventional foot prostheses and Merlette is an example of a foot prosthesis, Bryant's attachment is obvious for use on Merlette's foot prosthesis (or that Merlette's foot prosthesis is may be substituted for the one shown in fig.5 of Bryant).

Allowable Subject Matter

Claim 53 is allowed.

Claims 5-7,12,13,17,19,20,22,36,37,45,46 and 48-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERYL MILLER whose telephone number is (571)272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheryl Miller/
Examiner, Art Unit 3738

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738